

### **REMARKS**

This responds to the Office Action dated 3 November 2004. Applicant respectfully requests reconsideration of the application in view of the foregoing amendments and following remarks.

Applicant submits herewith an amendment with new claims 14-18. Therefore, claims 1-18 remain pending in the present application. Applicant respectfully submits that the arguments offered below have resolved the rejections.

### **Response to Rejections Under 35 U.S.C. § 102**

The Examiner rejected claims 1-3, 6, 9, 10, and 12 under 35 U.S.C. § 102(b) as being anticipated by Giles (U.S. 6,017,284 issued to Applicant). In particular, the Examiner states that although Giles discloses an arrow with a rear tapered portion as opposed to a front tapered portion, one could arbitrarily label the rear portion the “front end” with no structural changes.

As the Examiner knows, for a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675,677 (Fed. Cir. 1988). However, as the Examiner has recognized, the rejected claims each include distinguishing limitations.

Claim 1 recites “a front end portion and a rear end portion; wherein the front end portion comprises a first outer diameter and the rear end portion comprises a second outer diameter, the first outer diameter being smaller than the second outer diameter.” Similarly, claim 10 recites “a tapered front end portion receptive of a point.” A “front

end portion” is not identical to a “rear end portion.” Giles *discloses* the exact opposite--not identity of--the recited claim limitations. Therefore, the rejection of the claims under §102 is improper.

Arrows, like many other products, have clear and well understood differences between “front” and “rear” ends or end portions. The Examiner alleged that labeling the “front” and “rear” of an arrow may be done “arbitrarily.” However, the ends of arrows are not arbitrary at all. The front end of an arrow always has some kind of arrow tip. The rear end of the arrow always has some type of arrow nock so that the arrow can be secured to or loaded on the bowstring. Just like an automobile and many other devices, the utility of an arrow would be severely impaired or destroyed if the “front” was arbitrarily used as the “rear.” You simply cannot “load” an arrow onto a bowstring without a nock on the rear end. One of ordinary skill in the art knows that there is a significant and well-understood difference between front and rear end portions of an arrow, and they are not arbitrarily labeled or identified. Giles does not disclose or suggest that the “front end portion” of an arrow may be “tapered” or have “a first outer diameter...smaller than the second outer diameter.” The Examiner has thus failed to establish a *prima facie case* of anticipation under § 102.

As shown in Fig. 10 of the present application, an arrow according to principles of the present invention may have much better penetration if the “front end portion” is tapered. Not so for an arrow with a tapered “rear end portion.” The difference between front and rear is meaningful. In addition, the front end portion of an arrow may be dependent on the weight and geometry of inserts and points for balance. Thus, the front end portion is not interchangeable with the rear end portion. There is nothing cited by

the Examiner to support the assertion that choosing front and rear end portions of an arrow can be done arbitrary. In fact “front” and “rear” end portions are not the same, and the choice between which end of an arrow is the “front” is certainly not arbitrary.

Further, the Examiner did not even address the limitations of other rejected claims. The Examiner has the burden of showing identity between the prior art and the claimed structure, and yet claim 2, for example, was not even addressed. Claim 2 states that “a length of the front end portion comprising the first outer diameter ranges between approximately 0.5 and 3.0 inches.” The Examiner has not shown or alleged that any prior art reference anticipates this range for the “front end portion.”

Accordingly, Applicant respectfully requests that the rejection of claims 1-3, 6, 9, 10, and 12 under 35 U.S.C. § 102(b) be withdrawn.

New claims 14-18 have been added to more comprehensively claim the invention. These new claims should be allowable over the cited prior art.

### **Response to Rejections Under 35 U.S.C. § 103**

The Examiner rejected claims 7, 8, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Giles. Specifically, the Examiner states that although Giles does not disclose a reduced inner diameter of 0.200 inches or an outer diameter of 0.275 inches, one would select the dimensions to suitably mount desired accessories.

Claims 7, 8, and 13 depend from independent claims, and, as discussed above, the independent claims should be allowable. Therefore, claims 7, 8, and 13 should also be allowed. Moreover, as the Examiner knows, the standard for a proper § 103 rejection is not what “one would select.” A proper § 103 rejection requires that the

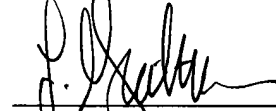
references *teach all of the claim limitations*. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Giles does not teach or suggest the claimed dimensions, and the claimed dimensions provide surprising results. *See, e.g.*, Figs. 10-13 and the associated description from the specification of the application. There must be specific disclosure or at least a suggestion of the unique dimensions claimed before a § 103 rejection is issued. A generic reference to what “one would select” is not sufficient for a proper § 103 rejection. Giles must actually teach the limitations or the § 103 rejection should be withdrawn. Therefore, claims 7, 8, and 13 should be allowable.

### **Conclusion**

Applicant believes the application is in condition for allowance. If the Examiner has any additional questions relative to the pending application, Applicant respectfully requests the Examiner to telephone the undersigned attorney to expedite the handling of this matter.

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Respectfully submitted,



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